

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 25, 2004. At the time of the Office Action, Claims 1-21 were pending in this patent application. The Examiner rejected Claims 1-21. Of these, Claims 1, 12 and 19 are independent. Applicants respectfully request reconsideration and favorable action in this case.

35 U.S.C. §103 Rejections

Claims 1-21 stand rejected under 35 USC 103(a) over Santoline et al. (PCT WO 97/38362) ("Santoline"), in view of "Admitted prior art" ("AD"), in view of Brown et. al. (U.S. Patent No. 6,377,859) ("Brown") and in view of Bowling (PCT WO 97/45778) ("Bowling"). Applicants respectfully traverse this rejection, and the assertions and determinations therein, for at least the following reasons.

Claim 1 recites, in part, "wherein the controller application is adapted to cause execution of the one of the control modules within the computer to simulate the operation of the one of the control modules including communicating with the further module to thereby simulate operation of the distributed process control system." The Examiner relies solely upon Bowling with respect to these elements of Claim 1 and the Examiner admits that none of Santoline, AD or Brown teach or suggest these elements of Claim 1. The Examiner states that Bowling allows the "design, test and verification of various control system strategies in a comprehensive manner *without* using the communication network or data highway [emphasis added]" and cites to page 4, paragraph 3 of Bowling. Office Action, p. 7. In contrast to the Examiner's assertion, Bowling indicates that users can simulate a control device while avoiding the need to design around a proprietary communication network or data highway, not that no communications network is present. Bowling, page 4, para 3. Indeed, Bowling states that "the invention provides an API ... to exercise the control algorithm program code. The API is designed to allow the actual device controller software to operate in a *non-proprietary communication's environment* [emphasis added]". Bowling, page 4, para 2. Therefore, Applicants respectfully submit that Bowling does not teach or suggest these elements of Claim 1.

Further, the combination of Santoline, AD, Brown and Bowling is improper. In particular, the Examiner relies upon AD with respect to Applicants' previous arguments that neither Santoline nor Bowling teach or suggest every element of Claim

1. See Official Action, p. 22-25, para 6.1-6.6. Applicants respectfully note that a proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. MPEP 2143.02. AD specifically notes that “with the system of Fig. 1, the controller application 23 and the process control modules 24 are loaded into and executed by the dedicated controller 12 and/or the field device 15 *before* the simulation application 36 can be used [emphasis added]”. Applicants’ specification, p. 8, lines 26-29, and Figure 1. To modify AD into a system “wherein the controller application is adapted to cause execution of the one of the control modules within the computer to simulate the operation of the one of the control modules including communicating with the further module to thereby simulate operation of the distributed process control system”, as recited, in part, by Claim 1, would fundamentally change the operating principles of the system of Figure 1.

Also, prior art must be considered in its entirety, including disclosures that teach away from the claims. MPEP 2141.02. As AD specifically teaches separation of the control modules and the control application from the computer, AD teaches directly away from the Examiner’s suggested use of Santoline, AD, Brown and Bowling to teach a system “wherein the controller application is adapted to cause execution of the one of the control modules within the computer” as recited, in part, by Claim 1. Therefore, the combination of Santoline, AD, Brown and Bowling is improper and Applicants respectfully request withdrawal of the combination of Santoline, AD, Brown and Bowling.

Thus, none of Santoline, AD, Brown or Bowling teaches or suggests every element of Claim 1 and Claim 1 is patentable over the cited references. Therefore, Applicants respectfully request allowance of Claim 1.

Independent Claim 12 is patentable over the cited references for reasons analogous to those presented above in association with Claim 1. Therefore, Applicants respectfully request allowance of independent Claim 12.

Independent Claim 19 recites, in part, “wherein the viewing application is adapted to communicate with the controller application and to use the display to display information sent from the further controller.” The Examiner admits that

Santoline does not disclose these elements, but asserts that a combination of Santoline, Bowling, Brown and AD discloses these elements.

While Bowling describes a first man-machine interface (MMI) through which a device controller can be monitored and/or controlled and a second MMI which can communicate with a simulation unit, Bowling does not disclose or suggest a single MMI that can communicate with a controller application and display information sent from a further controller. To the contrary, Bowling describes two separate MMIs: a first MMI for the device controller and a second MMI for the simulation unit. In a similar manner, the mere mention in the cited portions of Brown of decentralized process control systems and open communication protocols that allow devices by different manufacturers to interoperate does not appear to teach or suggest anything with respect to MMIs. Brown, col. 2, lines 1-25. Further, as discussed above in association with Claim 1, there is no motivation to combine Santoline, Bowling, Brown and AD. Thus, none of Santoline, AD, Brown or Bowling teaches or suggests every element of Claim 19 and Claim 19 is patentable over the cited references. Therefore, Applicants respectfully request allowance of independent Claim 19.

Dependent Claims 2-11 depend from independent Claim 1, dependent Claims 13-18 depend from independent Claim 12, and dependent Claims 20-21 depend from independent Claim 19. Independent Claims 1, 12 and 19 have been shown above to be allowable. Thus, dependent Claims 2-11, 13-18 and 20-21 are patentable as depending from an allowable base claim and as including further distinctions over the cited reference. Therefore, Applicants respectfully request allowance of dependent Claims 2-11, 13-18 and 20-21.

Conclusion

Applicants have now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and allowance of Claims 1-21.

A petition and an authorization to charge the fee for a two-month extension of time is included herewith. However, if a petition for a further extension of time under 37 CFR 1.136(a) is necessary to maintain the pendency of this case and is not otherwise requested in this case, Applicants request that the Commissioner consider this paper to be a request for an appropriate extension of time and hereby authorize the Commissioner to charge the fee as set forth in 37 CFR 1.17(a) corresponding to the needed extension of time to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP. Although Applicants believe that no other fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 13-2855 of Marshall, Gerstein & Borun LLP.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants respectfully request that the Examiner call its attorney at the number listed below.

Respectfully submitted for,

MARSHALL, GERSTEIN & BORUN LLP

By: 

Roger A. Heppermann

Reg. No: 37,641

6300 Sears Tower

233 South Wacker Drive

Chicago, Illinois 60606-6402

(312) 474-6300

Date: July 26, 2004